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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/525,491	09/16/2005	Evandro Luis Francischetti	60130-2366	7494

26096 7590 04/18/2007
CARLSON, GASKEY & OLDS, P.C.
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BIRMINGHAM, MI 48009

EXAMINER

KOTTER, KIP T

ART UNIT	PAPER NUMBER
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3617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/525,491	FRANCISCHETTI ET AL.	
	Examiner	Art Unit	
	Kip Kotter	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>23 February 2005</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “7” has been used to designate both “free end” in line 29 of page 5 and “side wall” in line 30 of page 5.
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference character(s) in Fig. 1 not mentioned in the description: **200**.
3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **40’**.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance. **No new matter should be entered.**

Specification

4. The disclosure is objected to because of the following informalities:

- In paragraph [4] of page 1, it is unclear what is meant by the phrase “A substantially U-shaped clamp projects that has a first end fixed”.
- In paragraph [7] of page 2, “little” should be changed to – **less** –.
- In paragraph [8] of page 2, it is unclear what is meant by the phrase “The recess includes a shoulder that functions as stop for projecting the balancing clamp”.
- In paragraph [11] of page 2, it is unclear where in pages 1 and 2 of the disclosure that lead has “already been discussed” as an active environmental pollutant.
- In paragraph [11] of page 3, it is unclear what is meant by the phrase “companies that make balance weights should be mindful of projects that exclude lead from the manufacture of balance weights”
- In paragraph [13] of page 3, it appears that the phrase “the wheel damages the paint of the wheel on which it is installed due to the friction between the wheel and the flange” should be changed to “the balance weight damages the paint of the wheel on which it is installed due to the friction between the U-shaped clamp and the flange.
- In paragraph [31] of page 5, it is unclear how the side walls can generate a centripetal force.
- In paragraph [33] of page 5, “instead of” should be changed to – **other than** – because lead is a metallic material.
- In paragraph [46] of page 8, “affect” should be changed to – **effect** –.

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Appropriate correction is required. **No new matter should be entered.**

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 2, 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 2, the limitation “a shape of an annular segment” renders the claim indefinite, as it is unclear what shape this limitation would comprise.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-4 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawabe (JP 11257433 A).

Regarding claims 1-4 and 14-16, Kawabe discloses a balance weight for use on a vehicle, the balance weight comprising: at least one body **24** having at least one magnetic element **25** that comprises a magnetic layer, wherein the at least one body has a shape of an annular segment as

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best understood by examiner as to what constitutes an annular-segment shape and is substantially metallic as described in paragraph [0021].

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 5-7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown (U.S. Patent No. 5733016) in view of Kawabe.

Brown discloses a balance weight **10** for use on a vehicle, the balance weight comprising: at least one body **14** and a substantially U-shaped clamp **18** associated with the at least one body.

Brown, however, fails to disclose the at least one body having at least one magnetic element and the clamp includes a magnetic layer.

Kawabe teaches the use of magnetic elements for securing balance weights to the wheel.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included a magnetic element for the balance weight of Brown, such as taught by Kawabe, to provide a balance weight that can be more easily removed and reused. Furthermore, it would have been obvious to have used a magnetic layer for the clamp of Brown to provide a more secure attachment because it is well-known to apply a magnetic material to an object in order to attach it to a ferrous article, such as with car sign magnets and refrigerator magnets.

11. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lejeune (U.S. Patent No. 3890008) in view of Kawabe.

Lejeune discloses a wheel, wheel rim and disc that comprise: a balance weight **10** including at least one body and an end region having a free end as shown in the figure and a cavity **11a** receiving the balance weight, wherein the cavity is substantially annular in shape and includes a substantially semicylindrical bottom surface at **11a** and two side walls **11b**, **12a** that project from the substantially semicylindrical bottom surface to provide a groove-like shape as shown in the figure.

Lejeune, however, fails to disclose the at least one body having at least one magnetic element.

Kawabe discloses a balance weight that includes at least one magnetic element **25**.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have included a magnetic element for the balance weight of Lejeune, such as taught by Kawabe, to provide a balance weight that can be more easily removed and reused.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references show other balance weights.

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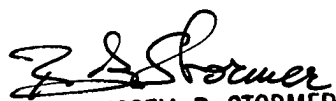
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kip Kotter whose telephone number is (571) 272-7953. The examiner can normally be reached on 9:00-4:00pm est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on (571) 272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KTK

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RUSSELL D. STORMER
PRIMARY EXAMINER 4/16/07